

ESTTA Tracking number: **ESTTA488821**

Filing date: **08/13/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202212
Party	Plaintiff Nemsi Books LLC
Correspondence Address	Nemsi Books LLC 307 W 3rd St, PO Box 191 Pierpont, SD 57468-0191 UNITED STATES psiccusa@dailypost.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Michael M. Michalak
Filer's e-mail	psiccusa@dailypost.com
Signature	/Michael M. Michalak/
Date	08/13/2012
Attachments	Notice of Opposition Amended.pdf ( 6 pages )(92414 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Nemsi Books LLC.	Opposition Nos. 91202212 (parent) 91202338
Opposer	In the matter of trademark application
v.	Serial Nos. 85184123 and 85184130
Karl May USA, Inc.	For the marks “SHATTERHAND” and “OLD SHATTERHAND”
Applicant	Published in the Official Gazette on : August 30, 2011 and September 6, 2011

---

**NOTICE OF OPPOSITION (AMENDED)**

Nemsi Books LLC, of South Dakota located at 307 West Third Street, PO Box 191, Pierpont, South Dakota 57468, (hereafter the Opposer) believes that it will be damaged by the registration of the marks shown in the above identified applications, and hereby oppose the same.

The grounds for opposition are as follows:

1. Opposer is, and has been since 2001, engaged in the production, development, sale and advertising of an extensive series of English language books and multi-media products based on the original German language works of the late German author Karl May [1842-1912], the original German language works having resided in the public domain since 1963 and embody the names of Shatterhand and Old Shatterhand.
2. Opposer has rights and interest in its English language works based on the original German language works authored by Karl May that contain the names of Shatterhand and Old Shatterhand.
3. Opposer asserts that the names are in the public domain and that it has used these names in commerce since 2001, however neither party has exclusive rights to these names.
4. From the time long prior to the filing of the Applications at issue, Opposer has disseminated the works, which include the Shatterhand and Old Shatterhand names as

they are the names of the fictional narrator of the stories told. As a result, the names have gained a valuable reputation and goodwill associated with the Opposer.

5. Opposer has long planned to expand its business to the visual media presentation of its published works and finally formed a production company to produce motion pictures based on its English language works that feature the character known as Shatterhand and Old Shatterhand on the 23<sup>rd</sup> February 2010.
6. Notwithstanding Opposer's long prior use of the names Shatterhand and Old Shatterhand in commerce, the Applicant filed an Intent to Use application on the 23<sup>rd</sup> November 2010 for the registration of the trademarks Shatterhand and Old Shatterhand in International Class 9 for "Motion picture films in the nature of action adventure and family films; audio and video tapes, compact discs and digital video discs featuring sound recordings, motion picture films, television programs, documentaries, musical theatrical productions and other live show performances; video and computer game programs; computer game software". And International Class 41 for "Production of motion picture films, television programs, theatrical productions and other live show performances; production of audio and video tapes, compact discs and digital video discs featuring sound recordings, motion picture films, television programs, documentaries, musical theatrical productions and other live show performances; entertainment services in the nature of professional entertainers dressed as characters appearing in motion picture films, television programs, television series and live show performances; providing a website featuring information about characters appearing in motion picture films and television programs; entertainment services, namely, providing online computer games and video games." As set forth above, these goods and services are the same that are pursued by the Opposer in the identical market and clearly indicated that the Applicant intends to compete with the Opposer, thereby trading on the Opposer's goodwill and reputation.

7. Applicant operates a web site where it claims to “own the rights to the use” of the names and associates the names with products that it does not own, produce or offer in commerce. Applicant’s owner also operated a web site wherein it is claimed that pending trademark applications are part of a franchise. Applicant and its owner are therefore seeking to monopolize marks on the basis of mere bad faith statements of intent to use in the future. Section 1(b) of the Lanham Act introduces a “good faith” standard by specifying that an application may be filed based on a bona fide intent to use a mark in commerce “under circumstances showing the good faith of such person.” Various pronouncements in the legislative history amplify this statutory language. According to Congress, the intent to use must be “in the ordinary course of trade” and not merely to reserve a right in a mark, and the bona fide intent to use must be present for all goods or services recited in the application. Opposer asserts that the Applicant’s association of the names with the character, titles and products not owned by the Applicant are false and show a bad faith intent to profit from the association by misleading the public into believing that the Applicant is the sole owner and sole source of the subject names in the United States of America.
8. Registration should therefore be refused pursuant to Section 43(a)(1)(B) of the Lanham Act on the grounds that false advertising is not limited to literal falsehoods but also extends to representations made by implication or innuendo [*Cook, Perkiss & Liehe, Inc. v. N. Cal. Collection Serv. Inc.*, 911 F. 2d 242 – Court of Appeals, Ninth Circuit], all to the damage of the Opposer.
9. Opposer will be damaged by the registration of the marks in the opposed Applications because registration will give Applicant prima facie evidence of its ownership of and its exclusive nationwide right to these marks that are confusingly similar to Opposer’s commercial offerings.

10. Registration should therefore be refused pursuant to Section 2(d) of the Lanham Act as amended (15 U.S.C. § 1053(d)) on the grounds that Applicant's Shatterhand and Old Shatterhand marks so resemble the names of the public domain fictional character as to cause confusion, mistake or deception as to the ownership of the fictional character, all to the damage of the Opposer.
11. If registration is allowed, Applicant's Shatterhand and Old Shatterhand marks will dilute the distinctiveness of the fictional character created by Karl May and disseminated in the works published and offered by the Opposer.
12. Opposer will be damaged by the registration of the Applicant's Shatterhand and Old Shatterhand trademark because such registration will support the dilution of the names and give color of exclusive statutory right to the Applicant in violation and derogation of the Opposer's equal right to use these names in commerce.
13. Registration should, therefore, be refused pursuant to Section 43(a) of the Lanham Act as amended (15 U.S.C. § 1125(c)) on the grounds that Applicant's Shatterhand and Old Shatterhand mark will cause dilution of the distinctive qualities of the famous names created by Karl May and popularized in the English language works published and offered by the Opposer.
14. Applicant and Opposer litigated a prior registration for the fictional character's name Winnetou wherein, during discovery, it was revealed that Applicant has no interest in the Shatterhand and Old Shatterhand names other than to cause the Opposer financial harm.
15. Registration should, therefore, be refused pursuant 15 U.S.C. § 1125(a) on the grounds that Applicant's Shatterhand and Old Shatterhand mark have been applied for in bad faith and are fomenting a false designation of origin and false or misleading representation of fact that is intended to deceive the public via the advertisement on the Applicant's web site claiming to own rights to the names in the United States of America, associating the names with products not produced or sold by the Applicant, thereby misleading the

public as to the source of products bearing or containing these names and by these actions cause the United States Patent and Trademark Office to allow these names to proceed towards registration with the sole intent to harm the Opposer.

16. Opposer hereby gives notice in accordance with Trademark Rule of Practice 2.122(f) that Opposer will introduce into evidence and rely on documents from a prior proceeding involving the parties that reveal the bad faith and non bona fide intent of the Applicant to use Shatterhand and Old Shatterhand in contravention of 15 U.S.C § 1051(b)

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the application for registration of the Shatterhand and Old Shatterhand marks be denied.

By  
/Michael M. Michalak/  
Michael M. Michalak MACS (Snr)  
CEO Nems Books LLC

Date August 13<sup>th</sup>, 2012

### **Certificate of Service**

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Karl May USA, Inc. by mailing said copy on August 13<sup>th</sup> 2012, via Priority Class Mail with return receipt (7011 2970 0000 0342 7520), postage prepaid to: Grant T. Langton c/o Connolly, Bove, Lodge and Huntz LLP 333 South Grand Avenue, Suite 2300 Los Angeles California 90071.

Signed

/Michael M. Michalak/  
Michael M. Michalak MACS (Snr.)  
CEO Nems Books LLC